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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,636	06/01/1999	JAMES E. BARRY	8688.6808	9457

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EXAMINER

LEE, Y MY QUACH

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/323,636

Applicant(s)

JAMES E. BARRY

Examiner

Y QUACH LEE

Group Art Unit

2875

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 7/30/2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 to 33 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1 to 16 and 30 is/are allowed.
- ☒ Claim(s) 24 and 26 to 28 is/are rejected.
- ☒ Claim(s) 17 to 23, 25, 29 and 31 to 33 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 2875

DETAILED ACTION***Response to Arguments***

1. Applicant's arguments filed July 30, 2002 with respect to claims 22, 24 and 26 have been fully considered but they are not persuasive. It should be noted that claims 22, 24, and 26 are not generic to all three embodiments disclosed in the specification, and the support for the specification amendments cannot be found in the original specification. The original specification does not disclose that the illumination member both illuminates a surrounding ground area (claim 22) and disposed in the removed portion of the body member (claim 24). The third embodiment discloses that the illumination member is attached to the bottom surface of the gasoline tank to illuminate the ground area rather than disposed in a removed portion of the body member (tank) to illuminate the ground area. Claim 26 under 35 USC 112, second paragraph, has not been overcome. Rejection of claims 24 and 26 stands still and follows. Applicant's arguments with respect to claim 27 have been considered but are moot in view of the new ground of rejection.

2. The amendment filed July 30, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, "In one embodiment a portion of the body member is removed and at least a portion of the illumination member is disposed therein" as recited on lines 9 to 11 of page 2 of the amendment of July 30, 2002, which is not supported by the original disclosure. Note that there is no support for the illumination member to both illuminates a surrounding ground area adjacent to the motorcycle and to dispose in a portion of the body member which is removed as presented in the original specification. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

3. Claims 17 to 26, 28, 29, 32 and 33 are objected to because of the following formalities: In claim 17, line 7, the term "a", first occurrence, should be changed to --the-- in view of lines 3 to 4. On line 8, the term "motorcycle" should be changed to --conventional motorcycle--. In claim 18, line 6, the term "a", second occurrence, should be changed to --the--. In claim 22, line 7, the term "motorcycle" should be changed to --conventional motorcycle--. In claim 26, line 8,

Art Unit: 2875

the term "a" should be changed to --the-- in view of line 1. In claim 32, line 11, the term "a ground area" should be changed to --the front and side ground area-- in view of lines 1 to 2. Claims 19 to 21 and 29 depend on objected claim 17 and as such are also objected. Claims 23 to 25 depend on objected claim 22 and such are also objected. Claim 28 depends on objected claim 26 and as such is also objected. Claim 33 depends on objected claim 32 and as such is also objected. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not provide support for "removing a portion of the body member and disposed at least a portion of the illumination member therein (claim 24) while this same illumination member illuminates surrounding ground area (claim 22). The third embodiment discloses that the illumination member is attached to the bottom surface of the gasoline tank to illuminate the ground area rather than disposed in a removed portion of the body member (tank) to illuminate the ground area. Applicant is required to cancel the new matter in the reply to this Office Action.

5. Claims 26 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, the language "light from the illumination assembly is directed away from the motorcycle gasoline tank or motorcycle hollow body shell to illuminate a ground area ..." are considered to be misdescriptive and/or inaccurate. For instance, light itself is a luminous flux and it is non-directional. In view of the drawing and the specification, without the reflective surface (314), the light is not directed away from the body member. It is suggest that the language " having a reflective member and" should be inserted after "assembly" on line 3.

Claim 28 depends on rejected claim 26 and as such is also rejected.

Art Unit: 2875

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Friedrich (555,689).

A non-transparent body member (figures 1, 3, 6) such as a motorcycle gasoline tank adapted for attachment to a frame of a motorcycle where a motorcycle gasoline tank is normally disposed, and an illumination member (1, figure 3) secured to the body member.

8. Claims 1 to 16 and 30 are allowed.

9. Claims 17 to 23, 25, 29, 32 and 33 would be allowable if rewritten to overcome the objection(s) set forth in this Office action.

10. Claims 26 and 28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

11. Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 703-308-1939. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

*Art Unit: 2875

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Y. Q.
October 17, 2002


Y Quach Lee
Patent Examiner
Art Unit 2875